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IN THE

Supreme Court of the United States.

OCTOBER TERM, 1966.

No.

JOHN C. KRANTZ, JR. AND LOUISE SPEERS CROIX,
Petitioners,

v.

JOHN F. OLIN,
Respondent.

RESPONDENT'S BRIEF IN OPPOSITION TO PETITION FOR A WRIT OF CERTIORARI.

SUMMARY OF ARGUMENT.

Respondent opposes the granting of this Petition for the following reasons:

I. The Petition is based entirely upon assumptions of fact that are not supported by the record. The record is contrary to Petitioners' assertions that the uses described in Respondent's patent application are "sham" or "spurious" or "unsafe" for practical use.

II. There was no mistake of law as claimed by Petitioners; the alleged conflict with *Brenner v. Manson*, 383 U. S. 519 (1966), does not exist.

III. The public interest does not require consideration of this case; no new issues are presented that were not fully treated in *Brenner v. Manson.*

ARGUMENT.

I. The Petition Is Based Upon Unsupported Assumptions of Fact.

In the first question proposed by Petitioners (Petition, page 3), Petitioners ask:

> "I. Can the utility which is essential to make an invention patentable be supplied by sham recitations of a spurious utility for which the invention is practically useless?"

This question raises non-existent issues since the record is clear that the utilities recited in Respondent's application are neither "sham" nor "spurious" nor "practically useless."

Respondent's patent application contains the following statement concerning utility of the chemical compound in question (R. 1, T-11):[1]

> "The resulting new chemical compound of my invention, bis(2,2,2-trifluoroethyl)ether, is a colorless liquid which vaporizes readily at ordinary temperatures and has useful solvent properties. For example, it may be used to prepare pastes or dispersions of high molecular fluorine compounds such as fluorocarbon waxes. It may also be used to soften or solubilize polymeric materials, e.g. synthetic fibers. It is chemically reactive and may be used in the preparation of other fluorinated compounds."

Not only have Petitioners failed to demonstrate that the above statements concerning utility are "sham" or "spurious", they have instead proved, through their own experts, the truth of these statements. Petitioners' own experts have shown that the compound is indeed a solvent

1. Respondents adopt Petitioners' notation for citations to the Record. See the footnote page 1 of the Petition.

for, and effective in, the preparation of paste and dispersions of, "high molecular weight fluorine compounds such as fluorocarbon waxes." See R. 1, T-186 where Petitioners' expert states in an affidavit dated November 15, 1962 that:

> "Tests similar to those described in the preceding paragraph were conducted on three fluorinated synthetic polymeric materials, Kel-F Grease, Halocarbon Wax 1200 and Halocarbon Wax 600.[2] These three materials were found to be soluble in hexafluorodiethyl ether,[3] forming from 10% to 13% solutions."

Petitioners' expert Neely worked with pastes of Kel-F, a high molecular weight fluorocarbon compound, and reports this fact in his affidavit dated January 2, 1963 where he states *inter alia* (R. 1, T-181):

> ". . . paste dispersions of the agent were prepared including, for example, a dispersion of Kel-F (a commercial designation for trifluorochloroethylene polymer). The paste containing about 20% of the hexafluorodiethyl ether, . . .".

Petitioners' experts also proved, as stated in Respondent's patent application, that the compound "may be used to soften or solubilize polymeric materials, e.g. synthetic fibers." See for example the affidavit of Wamser dated November 15, 1962 (R. 1, T-185, 186) where Wamser states under oath:

> "A variety of nonfluorinated synthetic polymeric materials were exposed in a closed vessel to hexafluorodiethyl ether for a period of ten days. Polystyrene, Nylon, Mylar, Orlon, Dacron, Acrilan and Dynel were all found to be insoluble with no evidence of any softening or swelling. In the case of polyethylene and cellulose acetate, there was no evidence of solubility, although some softening or swelling of these materials

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2. All three materials are fluorocarbon waxes.
3. The compound produced by the process in issue in this case.

were observed. Polyvinylidene chloride was found to be slightly soluble as evidenced by the appearance of non-volatile material in the liquid upon evaporation. Polymethacrylate was the only one of the nonfluorinated polymers tested that appeared to be significantly soluble in this agent."

It should be noted that Respondents make no claim in their patent application that the compound in question is a universal solvent. Wamser's work clearly demonstrates that the compound is a solvent for, and has a softening or solubilizing effect on a significant number of the polymeric materials tested.

In light of the work performed by Petitioners' own experts, there is no justification for Petitioners' stated conclusions that the uses described in Respondent's patent application are "sham" and "spurious". Petitioners seem to base their contention largely on the assumption that use as a solvent for the stated materials is not a "practical" use. Petitioners ignore the common knowledge that many chemical compounds have their principal, if not exclusive, economic value as solvents.

The Court of Customs and Patent Appeals (hereinafter referred to as CCPA) specifically held (R. 1, T-8a-10a), as had the Board of Patent Interferences (R. 1, T-23a-25a), that Respondent's statements of utility were properly included in Respondent's application and were adequate, citing the *Telephone Cases,* 126 L. Ed. 863 at page 990 (R. 1, T-9a).

In the second question proposed by Petitioners, they ask (Petition, page 3):

"II. Has an applicant for patent, who withholds from his application information essential for the safe use of the invention for the purpose recited in the application, made a sufficient disclosure to the patent office to form the basis of a complete and allowable application on which a valid patent can issue?"

This second question also presupposes facts that are not supported by the record. Petitioners contend that Respondent has withheld information essential for the safe use of the compound as a solvent. The sole basis for this contention is the report made by Respondent's pharmacologist, Dr. A. R. Latven, to the Respondent pointing out the toxic nature of the compound based on tests on mice exposed to an atmosphere containing the compound. Petitioners' apparent contention is that because of Olin's failure to include some statement in his application concerning the possible toxicity of the compound to humans, anyone attempting to employ the compound for its stated uses, (e.g. as a solvent for fluorocarbon compounds) might have difficulty in doing so because of the toxicity problem.

The difficulty with Petitioners' position is that there is no evidence in the record that the toxicity level of the compound is so high or unusual that it could not be safely used for all purposes described in Respondent's patent application, using only the reasonable precautions one would normally take with a volatile compound. There is nothing in the record to show that any of the original experimenters, who prepared and worked with the compound before its convulsant properties were known, suffered any ill effects from the compound. Nor is there any evidence that in the subsequent preparation and handling of the compound, there were any accidents involved in its use. Indeed the record shows that the compound is approved by the Federal Food and Drug Administration for administration to humans for psychiatric therapy purposes. In short, there is not a shred of evidence to support Petitioners' contention that the compound is so hazardous that it cannot be used as a solvent or for other purposes.

It is a well known fact, alluded to both by the Board of Patent Interferences and by the CCPA that many commercial solvents are dangerous to handle, but this does not prevent their use. See page 22a of the Petition where the Board of Interference Patent Examiners in a statement

specifically approved by the CCPA (See Petition page 7a) discuss this point as follows:

> "We cannot agree with Krantz et al.'s position that the subject matter of the Olin applications is dangerous to the public and for that reason cannot serve as constructive reductions to practice. The record is decidedly to the contrary. It shows that the compound was safely handled while it was being prepared, and used for experimental and testing purposes. * * * It is, therefore, unnecessary to explore this aspect of the case in any great depth. There is of record pages 7 to 23 of The Handbook of Solvents,[4] Scheflan and Jacobs, Tab 29, which are devoted to 'Safe Practices in the Use of Solvents.' On page 22, examples of labeling 'dangerous' solvents, recommended by the Manufacturing Chemists Association, are given. The handbook article shows that a good many solvents are more or less hazardous to use, but this fact alone does not prevent their use."

It is apparent from the foregoing that the "questions" proposed by Petitioners in this case raise fictitious issues based on assumed facts that do not find support in the record. For this reason alone, this Petition should be denied.

II. There Has Been No Mistake of Law: There Is No Conflict With Brenner v. Manson.

The Petitioners contend (Petition page 14-16) that the Petition should be granted to correct a mistake of law. The basis for this contention is stated by Petitioners as follows: (Petition page 15 (bottom)):

> "Petitioners believe that the lower court tried and decided this case upon the basis that no disclosure of utility was necessary to the patentability of the process claim in issue."

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4. See Appendix for pages 7-9 of the Handbook.

The most casual review of the CCPA's opinion in this case [5] shows immediately that Petitioners' belief is totally without foundation. It is clear beyond doubt that the CCPA carefully considered the statements of utility contained in Respondent's patent application and expressly found that those statements are accurate and adequate as proved by the tests carried out by Petitioners themselves. See page 5a (bottom) and page 6a (top) of the Petition where the CCPA refers to the statements in Respondent's patent application concerning utility. See also pages 6a, 7a, 8a and 9a of the Petition where Petitioners' contentions concerning the inaccuracy or inadequacy of Respondent's statement of utility are carefully considered and then rejected. On page 10a, the CCPA concludes as follows:

> "Clearly, Olin has complied with the law as set forth in the foregoing excerpt. The record shows that Speers produced pastes and solutions of fluorocarbon waxes, as pointed out above. Therefore, it is our view that the Olin cases are complete and allowable applications and that Olin is entitled to the filing date of his parent application, namely, December 29, 1955, for a constructive reduction to practice of the count; the Automatic Weighing Machine case, supra."

In taking the position that the CCPA decided this case on the ground that no utility disclosure is necessary, Petitioners contend that the Court must have been influenced by the arguments of Respondent's counsel with regard to the decision of the CCPA in *In re Manson,* 333 F. 2d 234 (CCPA 1964). The CCPA, however, did not adopt counsel's argument with respect to its holding in *In re Manson,* and indeed made no reference whatsoever to that decision. If the CCPA had relied upon *In re Manson* it would have been totally unnecessary for that Court to consider Petitioners' voluminous arguments directed solely to the inadequacy of Respondent's utility disclosures. The

5. Appendix II of the Petition, R. 1, T-3a et seq.

CCPA held *not* that a utility disclosure is unnecessary, but that Respondent had complied with the law by properly disclosing uses for the compound. The CCPA did not apply "the wrong ground rules" as contended by Petitioners, but applied the "ground rules" set forth by this Court in *Brenner v. Manson.*

It is apparent that the supposed conflict with *Brenner v. Manson* does not exist. *Brenner v. Manson* decided that a disclosure of utility for a compound whose uses are unknown is necessary to support a prima facie case for the patentability of the process for making the compound. Respondent's patent application does undeniably disclose uses for the compound in question. These uses have been held by the CCPA on the facts appearing in the record of this case to be correct and adequate.

The alleged "mistake of law" urged by Petitioners is another fictitious issue with no foundation in the record.

III. The Public Interest Does Not Require the Granting of this Petition.

The Petitioners' urge (page 12-14 of their Petition) the granting of this Petition in the interest of putting an end to the supposed practice of reciting "spurious and sham" utilities in patent applications. The fundamental difficulty with Petitioners' contention is that they have not established, nor does the record support, the underlying premise that the uses stated in Respondent's patent application are, in fact, "sham" "spurious" and "not practical." The record establishes the contrary and the CCPA so held.

In view of *Brenner v. Manson,* no additional ruling by this court is necessary to establish the principle contended for the Petitioners, namely the principle that an adequate disclosure of utility is necessary to support patentability. In *Brenner v. Manson,* this court considered this issue in depth only last year and clearly stated its position. No further clarification of this Court's position on this point would result from the granting of this Petition.

CONCLUSION.

The decision below is correct; no question warranting further review by this Court is presented, and there is no conflict of decisions. The petition for a writ of certiorari should be denied.

Respectfully submitted,

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and
WILLIAM M. EPES,
Attorneys for Respondent.